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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,063	07/06/2001	Max F. Rothschild	P02285US5	8599
22885	7590	11/07/2003	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			FREDMAN, JEFFREY NORMAN	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 11/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n No.

09/900,063

Applicant(s)

ROTHSCHILD ET AL.

Examiner

Jeffrey Fredman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

THE REPLY FILED 27 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.


The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-3, 7-11, 14, 16-20, 26-29, 36, 41, 45, 49, 54 and 55.Claim(s) withdrawn from consideration: 4-6, 12, 13, 15, 21-25, 30-35, 39, 42-44, 46-48 and 50-53.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
Jeffrey Fredman  
Primary Examiner  
Art Unit: 1634

Continuation of 3. Applicant's reply has overcome the following rejection(s): In view of the cancellation of claim 40, the 102 rejection is withdrawn.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant first argues the written description rejection. Applicant admits that "Although the specification does not explicitly list all other underlying gene and the same trait possible polymorphisms, it does state that one could use the method described in the specification to "evaluate pig DNA, genetically type individual pigs, and detect genetic differences in pigs (see page 13 of response)" The issue in the written description rejection is not whether further testing, further work or additional experimentation would be capable of determining polymorphisms in the gene. This is a distinct rejection from the enablement rejection. The issue with the claims is that there is a disclosure of only a particular set of polymorphisms, not all polymorphisms associated with the phenotypic trait. There is no expectation of any common structural features between these polymorphisms to guide the ordinary practitioner in determining, a priori, which polymorphisms have the phenotypic association required by the claim. So there is no description of which polymorphisms, other than those expressly disclosed, will share the phenotypic trait of being litter size associated, and which will not. In particular, the claim still also reads on "regions". As noted in the final rejection, this is precisely the problem identified by the court in Lilly, which noted "naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material."

With regard to the enablement rejection, the deletion of MseI from the dependent claim does not remove this species, and all other unknown polymorphisms, from the independent claim. While the screening itself may be capable of being performed, the result of the screening is entirely unpredictable. This unpredictability was fully discussed in the final rejection...